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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,449	08/25/2001	Thomas J. Pearsall		3649

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/939,449	Applicant(s) PEARSALL ET AL. <span style="float: right;">CPA</span>	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-19 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 20-22 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Withdrawn Rejections***

1. The 35 U.S.C. 112 rejections of claims 1, 4 – 6, 9 – 11 and 15 – 17 of record in Paper #3, Pages 3 – 4, Paragraphs 7 and 8 have been withdrawn due to Applicant's amendments and explanations in Paper #4.
2. The 35 U.S.C. 102 rejections of claims 1 – 5, 8 – 11 and 18 as anticipated by Campione et al. of record in Paper #3, Page 4, Paragraph 10 has been withdrawn due to Applicant's amendments in Paper #4.
3. The 35 U.S.C. 102 rejections of claim 25 as anticipated by Cozzini et al. of record in Paper #3, Page 5, Paragraph 11 has been withdrawn due to Applicant's amendments in Paper #4.
4. The 35 U.S.C. 103 rejections of claims 6, 7, 23 and 24 over Campione et al. in view of Cozzini et al. of record in Paper #3, Pages 5 and 6, Paragraph 13 has been withdrawn due to Applicant's amendments in Paper #4.
5. The 35 U.S.C. 103 rejections of claims 12, 15 – 17 and 19 over Campione et al. in view of Cohen of record in Paper #3, Pages 6 and 7, Paragraph 14 has been withdrawn due to Applicant's amendments in Paper #4.

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6. The 35 U.S.C. 103 rejections of claim 13 over Campione et al. in view of Cozzini et al. and further in view of Cohen of record in Paper #3, Pages 7 and 8, Paragraph 15 has been withdrawn due to Applicant's amendments in Paper #4.

7. The 35 U.S.C. 103 rejections of claim 14 over Campione et al. in view of Cohen and further in view of Cozzini et al. of record in Paper #3, Pages 5 and 6, Paragraph 13 has been withdrawn due to Applicant's amendments in Paper #4.

### *New Rejections*

#### *Claim Rejections - 35 USC § 112*

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the honing surface having a roughness, does not reasonably provide enablement for a roughness between 120 and 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to find the invention commensurate in scope with these claims. There are no units given for the roughness value, and therefore, prior art with a similar range cannot be found.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said honing surface characterized by a surface finish of Ra 120 to Ra 10" is unclear, which renders the claim vague and indefinite. It is unclear what the magnitude of the roughness value is since there are no units of measurement.

The phrase "characterized by" in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear if the Applicant is trying to say the article comprises or the surface consists of the roughness value as indicated.

Correction/clarification is required.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1 – 3, 5, 8 – 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campione et al. (USPN 5,458,534) in view of Meyer (USPN 5,853,319).

Campione et al. discloses a knife sharpening device with a aluminum metal body (Column 3, lines 51 – 54) with a handle (Column 4, lines 4 – 5) and a ceramic sharpening surface selected from aluminum oxide, silicon carbon and diamond (Column 3, lines 59 – 62). The sharpening surface is a flat area (Figure 1, #7) affixed in a recess (Figure 3, #10). A rectangular metal body (Column 4, lines 62 – 63) supports the abrasive area (Figure 3, #7 and 10). However, Campione et al. fails to disclose the ceramic coating created in an electrolytic bath and a honing surface characterized by a surface finish of Ra 120 to Ra 10.

Meyer teaches that the size of the grains on grinding tool is directly related to the roughness of the surface and chip removal (Column 2, lines 50 – 62) on a grinding tool for the purpose of determining the amount of the surface that is removed from the item being grinded.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the appropriate grain size to get the selected roughness in Campione et al. in order to determine the amount of the surface that is removed from the item being grinded as taught by Meyer.

Regarding the limitation of the ceramic coating being created in an electrolytic bath in claim 1, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and

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MPEP §2113. In this case, the limitation of creating the coating by an electrolytic bath is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

14. Claims 6, 7 and 23 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campione et al. in view of Meyer as applied to claims 1 – 3, 5, 8 – 11 and 18 above, and further in view of Cozzini et al. (USPN 5,046,385).

Campione et al., as modified with Meyer, disclose a knife sharpening device with a aluminum metal body (Column 3, lines 51 – 54) with a handle (Column 4, lines 4 – 5) and a ceramic sharpening surface selected from aluminum oxide, silicon carbon and diamond (Column 3, lines 59 – 62). The sharpening surface is a flat area (Figure 1, #7) affixed in a recess (Figure 3, #10). A rectangular metal body (Column 4, lines 62 – 63) supports the abrasive area (Figure 3, #7 and 10) and a honing surface with a selected roughness. However, Campione et al. fails to disclose a curved honing surface, a V groove, an elongated metal body having a ceramic surface

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on at least two contour portions selected from flat, rounded edge and tapered and the metal body being aluminum.

Cozzini et al. teaches a V groove, a tapered contour portion, (Column 2, lines 4 – 7 and Figure 2, #8 and 10) and an abrasive strip with rounded edges (Figure 1, #20 and Column 2, line 52 to Column 3, line 9) formed from a variety of hardened materials (Column 2, lines 15 – 18) in a sharpening device with a metal body (Column 1, lines 47 – 50) for the purpose of have a device capable of sharpening and straightening both sides of a knife while being used by either a right or left handed person.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the tapered, rounded portions or V groove of the sharpening device in the modified Campione et al. in order to have a device capable of sharpening and straightening both sides of a knife while being used by either a right or left handed person as taught by Cozzini et al.

15. Claims 12, 15 – 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campione et al. in view of Meyer as applied to claims 1 – 3, 5, 8 – 11 and 18 above, and further in view of Cohen (USPN 4,611,437).

Campione et al., as modified with Meyer, discloses a knife sharpening device with a



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aluminum metal body (Column 3, lines 51 – 54) with a handle (Column 4, lines 4 – 5) and a ceramic sharpening surface selected from aluminum oxide, silicon carbon and diamond (Column 3, lines 59 – 62). The sharpening surface is a flat area (Figure 1, #7) affixed in a recess (Figure 3, #10). A rectangular metal body (Column 4, lines 62 – 63) supports the abrasive area (Figure 3, #7 and 10) and a honing surface with a selected roughness. However, Campione et al. fails to disclose a triangular profile and a rounded edge.

Cohen teaches a rounded edge (Figures 1 – 3, #24) on abrasive surfaces formed from ceramic material, aluminum oxide, (Column 3, lines 56 – 59) in a sharpening system having a triangular profile (Figures 1 – 4, #26 and 28) metal body (Column 4, lines 55 – 56) for the purpose of improving the sharpening of cutting edges of different items.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the rounded edges and triangular profile in modified Campione et al. in order to improve the sharpening of cutting edges of different items as taught by Cohen.

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campione et al. in view of Meyer and Cozzini et al. as applied to claims 1 – 3, 5 – 11, 18 and 23 – 25 above, and further in view of Cohen.

Campione et al., as modified with Meyer and Cozzini et al., discloses the claimed

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sharpening article except for the article having a triangular profile.

Cohen teaches a rounded edge (Figures 1 – 3, #24) on abrasive surfaces formed from ceramic material, aluminum oxide, (Column 3, lines 56 – 59) in a sharpening system having a triangular profile (Figures 1 – 4, #26 and 28) metal body (Column 4, lines 55 – 56) for the purpose of improving the sharpening of cutting edges of different items.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the rounded edges and triangular profile in the modified Campione et al. in order to improve the sharpening of cutting edges of different items as taught by Cohen.

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campione et al. in view of Meyer and Cohen as applied to claims 1 – 3, 5, 8 – 12 and 15 – 19 above, and further in view of Cozzini et al.

Campione et al., as modified with Meyer and Cohen, discloses the claimed edge sharpening article except for having at least one V groove.

Cozzini et al. teaches a V groove, a tapered contour portion, (Column 2, lines 4 – 7 and Figure 2, #8 and 10) and an abrasive strip with rounded edges (Figure 1, #20 and Column 2, line 52 to Column 3, line 9) formed from a variety of hardened materials (Column 2, lines 15 – 18) in

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a sharpening device with a metal body (Column 1, lines 47 – 50) for the purpose of have a device capable of sharpening and straightening both sides of a knife while being used by either a right or left handed person.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the tapered, rounded portions or V groove of the sharpening device in the modified Campione et al. in order to have a device capable of sharpening and straightening both sides of a knife while being used by either a right or left handed person as taught by Cozzini et al.

#### ***Response to Arguments***

18. Applicant's arguments with respect to claims 1 – 3, 5, 8 – 11 and 18 have been considered but are moot in view of the new ground(s) of rejection. However, since the Campione et al. reference is being maintained, the arguments will be responded to below.

In response to Applicant's argument that Campione et al. does not have a ceramic coating created by a electrolytic bath, no patentability is given to the process limitations in a product claim. See the above rejection of Campione et al. in view of Meyer.

19. Applicant's arguments with respect to claim 25 have been considered but are moot in view of the new ground(s) of rejection.

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20. Applicant's arguments with respect to claims 6, 7, 23 and 24 have been considered but are moot in view of the new ground(s) of rejection. However, since the Campione et al. reference is being maintained, the arguments will be responded to below.

In response to Applicant's argument that Campione et al. does not have a ceramic coating created by a electrolytic bath, no patentability is given to the process limitations in a product claim. See the above rejection of Campione et al. in view of Meyer.

21. Applicant's arguments with respect to claims 12, 15 – 17 and 19 have been considered but are moot in view of the new ground(s) of rejection. However, since the Campione et al. and Cohen references are being maintained, the arguments will be responded to below.

The Examiner is unclear what the Applicant is trying to point out with the arguments regarding the claims. The Applicant refers to the ceramic honing surface in the arguments while the claims are drawn to the abrading surface. The applied references are being used against the abrading surface and not the honing surface.

22. Applicant's arguments with respect to claims 13 and 14 have been considered but are moot in view of the new ground(s) of rejection. However, since the Campione et al. reference is being maintained, the arguments will be responded to below.

In response to Applicant's argument that Campione et al. does not have a ceramic coating

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created by a electrolytic bath, no patentability is given to the process limitations in a product claim. See the above rejection of Campione et al. in view of Meyer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

June 15, 2004

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

6/15/04